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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/920,571

07/31/2001

Roger S. Lasken

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23859 7590 03/06/2007

NEEDLE & ROSENBERG, P.C.

SUITE 1000

999 PEACHTREE STREET

ATLANTA, GA 30309-3915

EXAMINER

STRZELECKA, TERESA E

ART UNIT

PAPER NUMBER

1637

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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31 DAYS

03/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/920,571

Applicant(s)

LASKEN ET AL.

Examiner

Teresa E. Strzelecka

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-9,14,20,22-25,27,29,35-39,41,42,44-49,51-53,55-59 and 69-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/28/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1,5-9,14,20,22-25,27,29,35-39,41,42,44-49,51-53,55-59 and 69-84.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species:

Species of fluorescent labels

- A) the fluorescent label is a CyDye and the CyDye is Cy2 (claims 72, 73),
- B) the fluorescent label is a CyDye and the CyDye is Cy3 (claims 72, 73)
- C) the fluorescent label is a CyDye and the CyDye is Cy3.5 (claims 72, 73)
- D) the fluorescent label is a CyDye and the CyDye is Cy5.5 (claims 72, 73)
- E) the fluorescent label is fluorescein (claim 74),
- F) the fluorescent label is 5,6-carboxymethyl fluorescein (claim 74),
- G) the fluorescent label is Texas red (claim 74),
- H) the fluorescent label is nitrobenz-2-oxa-1,3-diazol-4-yl (NBD) (claim 74),
- I) the fluorescent label is coumarin (claim 74),
- J) the fluorescent label is dansyl chloride (claim 74),
- K) the fluorescent label is rhodamine (claim 74).

Species of dNTPs

- L) at least one said dNTP is a fluorescence-labeled nucleotide (claim 75),
- M) at least one said dNTP is fluorescein- isothiocyanate-dUTP (claim 76),
- N) at least one said dNTP is Cyanine-3-dUTP (claim 76),
- O) at least one said dNTP is Cyanine-5-dUTP (claim 76),
- P) at least one said dNTP is modified (claim 77),
- Q) at least one said dNTP is modified with biotin (claim 78),
- R) at least one said dNTP is modified with a hapten (claim 78),

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S) at least one said dNTP is a nucleotide analog (claim 79),

T) at least one said dNTP comprises a radioactive isotope (claim 80).

Species of labeling the TS-DNA

U) the label is incorporated into the TS-DNA during the formation of TS-DNA (claim 1, 81),

V) the TS-DNA is labeled with a labeled probe (claim 1, 82),

W) the TS-DNA is labeled with an intercalating label (claim 1, 83),

X) the TS-DNA is labeled by incorporation of a labeled dNTP (claim 1, 84).

The species are independent or distinct because, in the case of fluorescent labels, each has a different structure and emission characteristics; in the case of modified dNTPs, each has a different structure which leads to a differences in the final product obtained; and in the case of the labeling TS-DNA, each of the species results in the differences in method steps.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable, i.e., Applicants are required to elect one species from the set of fluorescent labels, one species from the set of modified dNTPs and one species from the set of TS-DNA labeling. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable

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generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teresa E. Strzelecka whose telephone number is (571) 272-0789. The examiner can normally be reached on M-F (8:30-5:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Teresa E Strzelecka
Primary Examiner
Art Unit 1637

Teresa Strzelecka
3/2/07